

APPLICANT(S): PALTI, Yoram et al.  
SERIAL NO.: 10/532,808  
FILED: April 26, 2005  
Page 4

### REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Applicants assert that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

### Status of Claims

Claim 20-25, 30-33 and 36 are pending in this application and are rejected.

Claim 22 has been amended herein and new claim 37 has been added. Applicants respectfully assert that these amendments to the claims add no new matter.

### CLAIM REJECTIONS

#### 35 U.S.C. § 112 Rejection

In the Office Action, the Examiner rejected claims 22-25, 30-33 and 35 under 35 U.S.C. § 112, second paragraph, as being indefinite. According to the Examiner, the limitation "said device comprising a pH-sensitive color-changing material placed on a optical window and a magnetic element" is confusing. In response, Applicants have amended claim 22 to clarify that this clause is intended to refer to two separate elements within the device, namely "a pH-sensitive color-changing material placed on an optical window" and "a magnetic element disposed within said device". Applicants respectfully request that this rejection be withdrawn.

#### 35 U.S.C. § 103 Rejection

In the Office Action, the Examiner rejected claims 22-25 and 30-36 under 35 U.S.C. § 103(a), as being unpatentable over Marshall (U.S. Patent No. 6,228,605 B1) in view of Iddan et al. (U.S. Patent No. 5,604,531) and the Ishiyama et al. article. Applicants respectfully traverse this rejection.

Marshall teaches a method for the *in vivo* detection of *H. pylori*, and the Examiner states that Marshall teaches all the steps of independent claim 22 except the autonomous *in vivo* sensing device, wherein the sensing is done by radio frequency and moving the *in vivo*

APPLICANT(S): PALTI, Yoram et al.  
SERIAL NO.: 10/532,808  
FILED: April 26, 2005  
Page 5

device to contact at least one location of the upper GI tract by an external magnetic field which moves said magnetic element and wherein the device comprises a pH-sensitive color-changing material placed on an optical window and a magnetic element disposed within the device. The Examiner states that Iddan et al. discloses an autonomous *in vivo* sensing device, wherein the sensing is done by radio frequency, an pH sensor elements that are described in the prior art, and that the Ishiyama et al. article discloses moving an *in vivo* device by an external magnetic field which moves said magnetic element.

Applicants note that independent claim 22 recites that the autonomous *in vivo* sensing device comprises a pH-sensitive color-changing material placed on an optical window of the device and the step of “sensing pH at the location of the upper gastrointestinal tract using said pH-sensitive color-changing material”. The Examiner states that this “would have been a common sense approach” and it would have been obvious to place the color changing material on the optical window. Applicants dispute the characterization by the Examiner of this feature being obvious. Indeed, as the instant application and Iddan et al. are commonly owned by the assignee of the instant application, Applicants are very familiar with the disclosure of Iddan et al. and are comfortable asserting that sensing pH at the location of the upper gastrointestinal tract using pH-sensitive color-changing material placed on an optical window of the device was not contemplated by Iddan et al. and is not obvious based upon the disclosure of Iddan et al. Applicants respectfully request that the Examiner withdraw his reliance on Iddan et al. for this feature and provide a reference for this specific structure as contemplated by the claims.

In addition, Applicants note that independent claim 22 recites the step of “moving the autonomous *in vivo* device to contact at least one location of the upper gastrointestinal tract by an external magnetic field which moves said magnetic element”. Applicants contend that this step requires that the capsule be moved intentionally to contact at least one location of the upper gastrointestinal tract, e.g., the stomach wall. While Ishiyama et al. refers to moving an *in vivo* device by an external magnetic field which moves a magnetic element, Ishiyama et al. do not specifically teach that the capsule must intentionally contact at least one location of the upper GI tract. The claim step is quite different from the capsule possibly (or even probably, but possibly not) coming into contact with the stomach wall during its travels through the stomach.

APPLICANT(S): PALTI, Yoram et al.  
SERIAL NO.: 10/532,808  
FILED: April 26, 2005  
Page 6

Applicants have also added new claim 37, dependent upon claim 22, which recites that the step of moving comprises moving the capsule in a continuous track along the stomach wall. This new claim finds support at page 9, lines 3-10; page 12, line 15 - page 13, line 2; and page 14, lines 11-17; and FIG. 3). Applicants note that Ishiyama et al. do not teach the step of moving the in a continuous track along the stomach wall.

Applicants note that none of Marshall, Iddan or the Ishiyama et al. article discloses or suggests sensing pH at the location of the upper GI tract using a pH-sensitive color-changing material on the optical window of the in vivo device. In addition, none of Marshall, Iddan or the Ishiyama et al. article discloses or suggests moving the *in vivo* device to contact at least one location of the upper gastrointestinal tract by an external magnetic field which moves said magnetic element. Accordingly, amended independent claim 22 is not obvious over Marshall in view of Iddan and the Ishiyama et al. article.

Claims 23-25, 30-33 and 36, as well as new claim 37, include all the limitations of amended independent claim 22 and are therefore also not obvious over Marshall in view of Iddan and the Ishiyama et al. article. Applicants respectfully request that this rejection be withdrawn.

#### **Double Patenting Rejection**

Claims 22-25, 30-33 and 36 are provisionally rejected for obviousness-type double patenting as being unpatentable over claims 18-21 of U.S. Patent Application No. 10/524,553 (common inventor, same assignee). According to the Examiner, although the conflicting claims are not identical, they are not patentably distinct from each other.

Applicants note that U.S. Patent Application No. 10/524,553 is still pending such that the obviousness-type double patenting rejection is only provisional as of now. Applicants again advise the Examiner that they will file a terminal disclaimer to overcome this obviousness-type double patenting rejection when claims of this application are held allowable and when U.S. Patent Application No. 10/524,553 has been held allowable or issues as a patent.

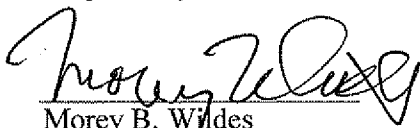
APPLICANT(S): PALTI, Yoram et al.  
SERIAL NO.: 10/532,808  
FILED: April 26, 2005  
Page 7

In view of the foregoing amendments and remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 50-3355.

Respectfully submitted,



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